

REMARKS

Claims 5-11 and Claims 13-16 are pending in the application.

Claims 5-11 and Claims 13-16 have been rejected.

Claims 5-11 and Claims 13-16 remain in the application.

Reconsideration of the claims of the patent application is respectfully requested.

Specification

The Specification has been amended to correct a typographical error. No new matter has been entered as a result of the amendment to the specification.

35 U.S.C. § 103(a) Obviousness

In the May 28, 2004 Office Action the Examiner rejected Claims 5-11 and Claims 13-16 under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 5,845,260 to Nakano et al. (hereafter “*Nakano*”) in view of United States Patent No. 4,837,422 to Dethloff et al. (hereafter “*Dethloff*”) and United States Patent No. 5,721,583 to Harada et al. (hereafter “*Harada*”). The Applicant respectfully traverses the Examiner’s position that the Applicant’s invention is obvious in view of the *Nakano* reference and the *Dethloff* reference and the *Harada* reference. The Applicant respectfully requests the Examiner to withdraw the rejection of Claims 5-11 and Claims 13-16 in view of the Applicant’s arguments.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny

patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish

obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

For the reasons set forth below the Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to Claims 5-11 and Claims 13-16 of the Applicant’s invention.

The *Nakano* reference recites a charging system for a parent to control spending by a child. The parent sets an imaginary account 2, shown in Figure 1 and Figure 3, for the child in a remote server/processor 1 of the service provider company. (Column 3, Lines 1-9 and Lines 51-55). When the child selects a desired service on a display device 4, a charge request is sent over a communications link to the remote server/processor 1 via a set-top box 3. (Column 3, Lines 11-15). The charge request includes the child’s identification data. (Column 3, Lines 15-17). The remotely

located server/processor 1 makes a determination whether the balance in the imaginary account 2 is sufficient or not. (Column 4, Line 62 to Column 5, Line 1). If so, the fee for the service is withdrawn from the imaginary account 2. (Column 5, Lines 25-29). *Nakano* does not disclose, suggest or even hint at the concept of using bio-authentication information.

The *Harada* reference recites an interactive television system including a remote center apparatus 101, shown in Figure 1, a terminal apparatus 102, a display apparatus 103 and remote control apparatuses 104, 105 and 106. (Column 15, Line 35 to Column 16, Line 6). The center apparatus 101 communicates via a CATV network with a plurality of terminal apparatuses 102. (Column 16, Lines 36-39). The terminal apparatus 102 supplies data to the display apparatus 103 and communicates with the remote control apparatuses 104, 105 and 106. (Column 16, Lines 39-47). Each remote control apparatus 104, 105 and 106 is assigned a unique remote control identification number identifying a particular user and stores personal attribute information for the user. (Column 16, Lines 8-10 and Lines 20-25). In addition, each terminal apparatus 102 is assigned a unique terminal identification number. (Column 16, Lines 11-13). The center apparatus 101 stores the terminal identification number and associated remote control identification numbers. (Column 16, Lines 14-20).

Each remote control apparatus 104, 105 and 106 can further be provided with user identification means, such as a password, fingerprint recognition or voice pattern recognition. (Column 7, Lines 14-22; Column 24, Line 66 – Column 25, Line 5; Column 25, Lines 55-59; and Column 26, Lines 15-17). Before inputting message data to be sent to the center apparatus 101, the user first inputs the necessary user-identification information to the remote control apparatus 104, 105 or 106, which compares the received user-identification information to stored user-identification

information to authorize the user. (Column 25, Lines 5-11). If the user is authorized, the user personal information and remote control apparatus identifier are read out and attached to a service request sent to the terminal apparatus 102, which in turn forwards the service request to the center apparatus 101. (Column 7, Lines 24-30; Column 25, Lines 12-22).

The Applicant respectfully traverses the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by *Nakano* to include elements of the device taught by *Harada*. Specifically, the Applicant traverses the Examiner's assertion that "It would have been obvious to one with ordinary skill in the art to include to Nakano et al bio-authentication information as the identification information because Harada et al teaches selectively controlling access (i.e. adults and children; col 4, lines 42-60). (May 28, 2004 Office Action, Page 5, Lines 15-18).

The supposed motivation to obtain "to selectively control access" is very general and does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to "selectively control access" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. *Nakano* does not disclose the concept of using bio-authentication information. *Harada* does not disclose the concept of a consumer electronics device having a local processor that operates in the manner as claimed by the Applicant. There is no suggestion or motivation to combine the teachings of the *Nakano* reference with the teachings of the *Harada* reference.

The *Dethloff* reference discloses the use of a multi-user “smart card.” The *Dethloff* device comprises a plastic “smart card” that contains at least one integrated circuit chip. (*Dethloff*, Column 1, Lines 12-20). The *Dethloff* device is referred to as a multi-user card (or “M-card”) because it is capable of storing data and making calculations for each of a plurality of users. The *Dethloff* device assigns a personal identification number (PIN) to each user. (*Dethloff*, Column 6, Lines 32-33). The PIN is used as an authentication code to access the M-card.

The *Dethloff* reference mentions the concept of using a voice print code instead of a PIN for authentication. “It is noted that while the PIN is given as an example of cardholder and sub-user enabling code, any other code can be used, such as a voice print (to be stored as data and input by the cardholder or sub-user) or an algorithm such as a ‘trapdoor’ algorithm mentioned above.” (*Dethloff*, Column 11, Lines 25-30). *Dethloff* does not specifically disclose a “voice sensor” (or any other type of bioauthentication device) within the *Dethloff* M-card.

The Applicant’s device as claimed in Claim 5 comprises “a bioauthentication device which provides bioauthentication information to the memory” of the device. The *Dethloff* M-card does not comprise a device within the *Dethloff* M-card that provides bioauthentication information to the memory of the *Dethloff* M-card.

The Examiner stated that the *Dethloff* reference discloses “sending account holder information over the communication link only if the match is detected and determining a sub-credit limit that is not exceeded (col 13, lines 67-68; col 14, lines 40-42). (May 28, 2004 Office Action, Page 4, Lines 13-15). The Applicant respectfully traverses this assertion of the Examiner. The cited portion of the *Dethloff* reference reads:

The procedure is in principle as follows
the machine checks the card authenticity;
the card checks the sub-user's identity (upon sub-user's inputting his/her PIN);
the card accepting machine checks available funds (to sub-user) and the term (sub-user's authorization terminating data; and;
if ok for funds and term, the card accepting device executes the transaction and updates the sub-user's transaction memory within the card. (*Dethloff*, Column 13, Line 67 to Column 14, Line 8).

From the portion of the *Dethloff* reference cited above it is clear that the "card accepting machine" is external to the *Dethloff* M-card and that the "card accepting machine" contains the sub-credit limit information against which it checks the "available funds (to sub-user)." Therefore, it is clear that the "card accepting machine" receives the user's account holder information over the communication link before the card accepting machine determines whether there are "available funds (to sub-user)" (i.e., that the sub-credit limit is not exceeded). Therefore, the *Dethloff* M-card does not operate in the manner of the Applicant's invention.

The Applicant respectfully submits that the alleged motivation to combine the *Nakano* reference and the *Harada* reference and the *Dethloff* reference presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that "It would have been obvious to one with ordinary skill in the art to include bio-authentication information as the identification information further as a voice sensor because Harada et al teaches such for privacy purposes (col 3, line 10-12) and non-eligible user participation (col 3, lines 40-42). (May 28, 2004 Office Action, Page 4, Lines 16-19). The Applicant respectfully traverses this assertion of the Examiner. The supposed motivations of "privacy purposes" and of "non-eligible user participation" are very general and do not specifically suggest combining the

teachings of the *Nakano* reference with the teachings of the *Dethloff* reference and with the teachings of the *Harada* reference. The fact that three references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention.

There is no “clear and particular” motivation (as required by the applicable law) to combine the concepts of bio-authentication as disclosed by *Dethloff* and by *Harada* with the account authorization device as disclosed by *Nakano*.

The Examiner stated that “It would have been obvious to one with ordinary skill in the art to include to Nakano et al a bio-authentication device for providing the bio-authentication information as fingerprint sensor because Dethloff et al teaches bioauthentication and Nakano teaches controlled access.” (May 28, 2004 Office Action, Page 6, Lines 1-4). The Applicant respectfully traverses this assertion of the Examiner. The supposed motivation to combine references is missing. The fact that *Dethloff* may teach bioauthentication and that Nakano may teach “controlled access” does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Dethloff* reference. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention.

The Examiner stated that “It would have been obvious to one with ordinary skill in the art to a local storage device for memory and further where the memory is part of the consumer electronics device because Harada et al teaches multiple user information at the consumer electronics

device for relational identification (col 17, lines 64-67). (May 28, 2004 Office Action, Page 5, Lines 1-4). The Applicant respectfully traverses this assertion of the Examiner. The supposed motivation to combine references is missing. The fact that *Harada* may teach the use of “multiple user information at the consumer electronics device for relational identification” does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention.

The Examiner stated that “It would have been obvious to one with ordinary skill in the art to include sending account holder information over the communication link only if the match is detected and determining a sub-credit limit that is not exceeded from Dethloff et al because Harada et al teaches local determination of user as important because personal information must be controlled (col 3, lines 8-9) and since Nakano teaches credit sub-limits which is a type of personal information. (May 28, 2004 Office Action, Page 5, Lines 5-10). The Applicant respectfully traverses this assertion of the Examiner for the reasons set forth below.

Harada does not teach or suggest sub-credit limits or making a determination with respect to the sub-credit limits. The Applicant respectfully submits that personal information does not teach sub-credit limits. However, even if the Examiner’s statement that credit sub-limits are a type of personal information is correct, the Examiner has not provided any teaching or suggestion in *Harada* of a determination with respect to the personal information. The remote control apparatus 104, 105 or 106 of *Harada* authorizes a user based on user-identification information. No processing

of the personal information at the remote control apparatus 104, 105 or 106 or terminal apparatus 102 is mentioned or suggested in *Harada*. Instead, the personal information is simply sent to the central apparatus 101 in a service request once the user is authorized. Therefore, the teachings of *Harada* are in effect similar to the teachings of *Nakano*. As a result, the Applicant respectfully submits the Applicant's invention is patentable over the *Nakano* reference and the *Dethloff* reference and the *Harada* reference, either separately or in combination.

Furthermore, the supposed motivation to combine the three references is legally insufficient. The fact that *Harada* may teach that "personal information must be controlled" does not of itself specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Dethloff* reference or with the teachings of the *Harada* reference. Similarly, the fact that *Nakano* teaches the use of credit sub-limits does provide a legally sufficient motivation to combine references. The fact that two or three references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Applicant's invention.

The Examiner stated "Harada et al discloses bio-authentication information as the identification information where bio-authentication device provides the bio-authentication information that is a fingerprint (col 7, lines 19-23) further where the sensor is on the remote control (col 7 lines 14-19). (May 28, 2004 Office Action, Page 5, Lines 11-14). The Applicant respectfully traverses this assertion of the Examiner. The supposed motivation to combine references is missing. The fact that *Harada* may teach the use of "bio-authentication information as the identification information" does not of itself specifically suggest combining the teachings of the *Nakano* reference

with the teachings of the *Harada* reference. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention.

Even if the *Nakano* reference could somehow be combined with the *Dethloff* reference and with the *Harada* reference, the combination would not teach, suggest, or even hint at the Applicant’s invention as set forth in Claims 5-11 and Claims 13-16. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant’s disclosure. In the present case, the *Nakano* reference and the *Dethloff* reference and the *Harada* reference in combination would not teach or suggest all the claim limitations of the Applicant’s invention.

The Applicant respectfully directs the Examiner’s attention to Claim 5.

5. (Previously presented) A consumer electronics device, comprising
a memory which stores account information for an account holder and sub-
credit limits and bioauthentication information for authorized users of the account;
a bioauthentication device which provides bioauthentication information to
the memory;
a communication link; and
a processor, which compares received bioauthentication information to
stored bioauthentication information to detect a match, and finds an associated
sub-credit limit corresponding to the received bioauthentication information, to
enable a purchase over the response network via the communication network up to
a maximum of the sub-credit limit, the processor sending the account holder
information over the communication link only if the match is detected and the
sub-credit limit is not exceeded. (Emphasis added).

The Applicant respectfully submits that neither the *Nakano* reference nor the *Dethloff*

reference nor the *Harada* reference teaches or suggests all of the claim limitations of Claim 5. The present invention comprises a local account authorization device in a consumer electronics device typically found in the home. In the present invention, the user sets up an account with sub-credit limits in a local consumer electronics device such as a set top box. The credit card information is not sent out on the network until after the bio-authentication information has been locally matched and the sub-credit limit has been locally determined. This element is not disclosed or suggested in the prior art.

Unlike the Applicant's invention, the *Nakano* device sends a charge request from set top box 3 over a communications link to remote server/processor 1. The remotely located server/processor 1 makes the determination with respect to the sub-credit limit. In the Applicant's device the local processor in the consumer electronics device does not send account information over a communication link to a remote location until after the local processor has (1) locally matched the bio-authentication information, and (2) locally determined that the sub-credit limit has not been exceeded. In the *Dethloff* device, the remotely located "card accepting machine" makes the determination with respect to the sub-credit limit.

The Applicant notes that Claims 6-11 depend directly or indirectly from Claim 5. As previously described, Claim 5 contains unique and novel claim limitations of the Applicant's invention. Therefore, Claims 6-11 also contain the same unique and novel claim limitations of Claim 5 and are therefore patentable over the *Nakano* reference and the *Dethloff* reference and the *Harada* reference, either separately or in combination.

The Applicant notes that Claim 13 and Claim 14 contain elements that are analogous to the unique and novel elements of Claim 5 that have been previously discussed. The Applicant further

notes that Claims 15-16 depend directly or indirectly from Claim 14. Therefore, Claims 15-16 also contain the same unique and novel claim limitations of Claim 14 and are therefore patentable over the *Nakano* reference and the *Dethloff* reference and the *Harada* reference, either separately or in combination.

The Applicant therefore respectfully submits that Claims 5-11 and Claims 13-16 are in condition for allowance. Allowance of Claims 5-11 and Claims 13-16 is respectfully requested.

The Applicant's attorney has made the arguments set forth above in order to place this Application in condition for allowance. In the alternative, the Applicant's attorney has made the amendments and arguments to properly frame the issues for appeal. In this Amendment, the Applicant makes no admission concerning any now moot rejection or objection, and affirmatively deny any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY

The Applicant respectfully requests consideration and allowance of the claims and that this patent application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this patent application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at fhamilton@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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